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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,080	10/12/2004	Andreas Ruthner	PAT-00356	7054
26/922	7590	07/15/2008		
BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192			EXAMINER TSOY, ELENA	
			ART UNIT 1792	PAPER NUMBER
			NOTIFICATION DATE 07/15/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/511,080

Applicant(s)

RUTHER ET AL.

Examiner

Elena Tsoy

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

Amendment filed on May 19, 2008 has been entered. No claims have been added or canceled. Claims 1-23 are pending in the application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-12, 14-15, and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer (US 5,633,037) and Applicants' admitted state of art for the reasons of record set forth in paragraph 3 of the Office Action mailed on 2/19/2008 because amendment does not change the scope of claimed invention.
3. Claims 4-5, and 13, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer for the reasons of record set forth in paragraph 4 of the Office Action mailed on 2/19/2008.

Response to Arguments

Applicant's arguments filed May 19, 2008 have been fully considered but they are not persuasive.

Applicants submit that Mayer does not teach or suggest that the basecoats applied in the refinish are of the same material as the basecoat applied in the original finish, and there is motivation in Mayer to modify Mayer in order to use the same material as the basecoat applied in the original finish. On page 2, final paragraph, of the present Office Action, the Examiner cites Mayer's column 3, lines 12-23 as teaching that the coating composition may be a pigment-free extract of the aqueous refinish basecoat material. However, it is respectfully submitted that no

such teaching is present in the Mayer at the above referenced section. Applicants respectfully submit that Mayer only teaches that the material used in the pigmented basecoat material of the refinish can be the same as the material used in the non-pigmented basecoat material of the refinish. (Mayer, column 14, lines 48-58). However, Mayer does not teach or suggest, or even allude to the basecoat in the refinish having the same material as the basecoat in the original finish, as is recited in independent claim 1. The foregoing comments are further affirmed in Mayer's exemplary embodiments. In Mayer's examples, the original finish comprised a basecoat based on cellulose acetobutyrate. (Mayer, column 17, lines 16-17). However, Mayer's basecoats 1-5 used in the refinish do not contain any cellulose acetobutyrate. (Mayer, column 21, line 5, to column 22, line 8).

The Examiner respectfully disagrees with this argument. Mayer teaches that *any* known basecoat compositions are suitable in his process (See column 16, lines 36-39). Mayer also does not limit his teaching to a particular original finish composition suitable for refinishing. In other words, Mayer does not limit his teaching to particular basecoat materials for original finish and for refinish. Thus, there are two obvious combinations: either the same or different known basecoat materials may be used in original and refinish basecoat compositions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the same basecoat materials for original finish and for refinish in Mayer since Mayer does not limit his teaching to particular basecoat materials for original finish and for refinish.

It is held that patents are relevant as prior art for all they contain. See *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). **Disclosed examples** and preferred embodiments **do not constitute a teaching away from a broader disclosure** or nonpreferred embodiments. See MPEP 2123. Therefore, Mayer's examples wherein the original finish comprised a basecoat based on cellulose acetobutyrate, does not teach away from a **broader disclosure**.

Moreover, Applicants admitted in P4 that "In order to prevent at least partly the shift in shade and change in optical effect, **OEM finishes** are refinished on the line at the automaker's plant using conventional basecoat materials, i.e., based on materials comprising organic solvents, whose shade and/or optical effect are adapted to those of the basecoats to be refinished.

However, this approach is very complicated, since a conventional basecoat material has to be prepared and stocked at the automaker's plant separately for every production shade and/or effect". Obviously, in on-line OEM refinishing, the same basecoat material should be used for original and refinish compositions since the refinish basecoat material should be adapted to those of the basecoats to be refinished.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.
Primary Examiner
Art Unit 1792

July 12, 2008

/Elena Tsoy /

Primary Examiner, Art Unit 1792